

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/441,966 11/17/99 HALL

R 98.736-A

020306 HM12/0928
MCDONNELL BOEHNEN HULBERT & BERGHOFF
300 SOUTH WACKER DRIVE
SUITE 3200
CHICAGO IL 60606

EXAMINER

TUNG, P

ART UNIT

PAPER NUMBER

1652

DATE MAILED:

09/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
09/441,966

Applicant(s)
Hall et al.

Examiner
Peter Tung

Art Unit
1652



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-18 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Art Unit: 1652

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-11, drawn to a method of accelerating the rate of mucociliary clearance comprising administering aprotinin, classified in class 514, subclass 2.
 - II. Claims 1-10, 12 and 16-18, drawn to a method of accelerating the rate of mucociliary clearance comprising administering the protein of SEQ ID NO: 49, classified in class 514, subclass 2.
 - III. Claims 1-10, 13 and 16-18, drawn to a method of accelerating the rate of mucociliary clearance comprising administering the protein of SEQ ID NO: 2, classified in class 514, subclass 2.
 - IV. Claims 1-10, 13 and 16-18, drawn to a method of accelerating the rate of mucociliary clearance comprising administering the protein of SEQ ID NO: 45, classified in class 514, subclass 2.
 - V. Claims 1-10, 13 and 16-18, drawn to a method of accelerating the rate of mucociliary clearance comprising administering the protein of SEQ ID NO: 47, classified in class 514, subclass 2.

Art Unit: 1652

- VI. Claims 1-10, 13 and 16-18, , drawn to a method of accelerating the rate of mucociliary clearance comprising administering the protein of SEQ ID NO: 70, classified in class 514, subclass 2.
- VII. Claims 1-10, 13 and 16-18, drawn to a method of accelerating the rate of mucociliary clearance comprising administering the protein of SEQ ID NO: 71, classified in class 514, subclass 2.
- VIII. Claims 1-10, 13 and 16-18, drawn to a method of accelerating the rate of mucociliary clearance comprising administering the protein of SEQ ID NO: 49, classified in class 514, subclass 2.
- IX. Claims 1-10, 14 and 16-18, drawn to a method of accelerating the rate of mucociliary clearance comprising administering the protein of SEQ ID NO: 4, classified in class 514, subclass 2.
- XI. Claims 1-10 and 14, drawn to a method of accelerating the rate of mucociliary clearance comprising administering the protein of SEQ ID NO: 5, classified in class 514, subclass 2.
- XII. Claims 1-10, 14 and 16-18, drawn to a method of accelerating the rate of mucociliary clearance comprising administering the protein of SEQ ID NO: 6, classified in class 514, subclass 2.

Art Unit: 1652

- XIII. Claims 1-10, 14 and 16-18, drawn to a method of accelerating the rate of mucociliary clearance comprising administering the protein of SEQ ID NO: 7, classified in class 514, subclass 2.
- XIV. Claims 1-10, 14 and 16-18, drawn to a method of accelerating the rate of mucociliary clearance comprising administering the protein of SEQ ID NO: 3, classified in class 514, subclass 2.
- XV. Claims 1-10, 14 and 16-18, drawn to a method of accelerating the rate of mucociliary clearance comprising administering the protein of SEQ ID NO: 50, classified in class 514, subclass 2.
- XVI. Claims 1-10, 14 and 16-18, drawn to a method of accelerating the rate of mucociliary clearance comprising administering the protein of SEQ ID NO: 1, classified in class 514, subclass 2.
- XVII. Claims 1-10, 14 and 16-18, drawn to a method of accelerating the rate of mucociliary clearance comprising administering the protein of SEQ ID NO: 52, classified in class 514, subclass 2.
- XVIII. Claims 1-10, 15 and 16-18, drawn to a method of accelerating the rate of mucociliary clearance comprising administering the protein of SEQ ID NO: 8, classified in class 514, subclass 2.
2. The inventions are distinct, each from the other because of the following reasons: Each of Groups I-XVII is directed to a separate and distinct invention. Each of the groups are directed

Art Unit: 1652

to a method of accelerating the rate of mucociliary clearance comprising administering a protease inhibitor. Each method differs in that a different protease inhibitor is used. These methods are distinct both physically and functionally, require different process steps, reagents and parameters and produce different products.

3. Upon the election of a restriction group, the claims of the group will be examined only to the extent of the specific sequence of the elected group.

4. Because these inventions are distinct for the reasons given above and the search required for each individual group is not required for the other groups, restriction for examination purposes as indicated is proper.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

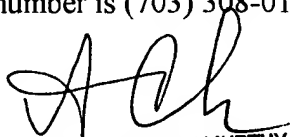
6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1652

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Tung, Ph.D. whose telephone number is (703) 308-9436. The examiner can normally be reached on Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy, Ph.D., can be reached on (703) 308-3804. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


PONNATHAPU ACHUTAMURTHY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600